

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Hildreth, John

Serial. No.: 10/828,350

Issued: November 27, 2007

Patent No.: 7,299,596

For: Framing System

* * *

Statement Under 37 CFR 3.73(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

Further to the Petition to Stay filed July 10, 2009 by Corsair Holdings, LLC, (the general partner of Corsair Special Situations Fund, L.P.) ("Corsair") and further to the Petition to Expunge Recorded Assignment filed on June 9, 2009 by John J. Hildreth ("Hildreth") enclosed please find a Statement Under 37 CFR 3.73(b) with attached Order from the United States District Court for the District of Maryland, Northern Division.

The following Attachments are enclosed:

- **Statement Under 37 CFR 3.73(b)**
- **Additional documentation related to Statement**
- **Order from the UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MARYLAND**

Remarks

I. Motion for Summary Judgment Granted.

Corsair had filed a complaint for breach of contract, declaratory judgment and injunctive relief in the United States District Court for the District of Maryland (Northern Division) (Corsair Special Situations Fund, L.P. v. Engineered Framing Systems, Inc., et al.). The motion for summary judgment as to damages and declaratory relief has been granted. As evidenced by the attached Order of the District Court for Case 1:09-cv-01201-PWG:

3. Corsair is the lawful assignee and owner of the Patent [(7,299,596)] along with any and all inventions and improvements described or claimed, divisions, continuations, continuations-in-part, reissues and extension, and all rights corresponding to any of the foregoing through the world;
4. Corsair can sell, assign, transfer, pledge, license or encumber the Patent free and clear from any claims of Defendant John J. Hildreth;
5. Defendant John J. Hildreth has no rights to the Patent or to use the patented technology [...]

We submit the attached Order should lay to rest any and all dispute related to ownership of U.S. Patent 7,299,596.

The US PTO is hereby authorized to charge to deposit account No. 50 1165 any fees that may be required.

Respectfully submitted,

By: 

Gianna Arnold
Reg. No. 36,358

Miles & Stockbridge P.C.
1751 Pinnacle Drive, Suite 500
McLean, Virginia 22102-3833
(703) 903-9000

June 22, 2010

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: CORSAIR SPECIAL SITUATIONS FUND, L.P.Application No./Patent No.: 7299596Filed/Issue Date: November 27, 2007Titled: Framing SystemCORSAIR SPECIAL SITUATIONS FUND, L.P., a Limited Partnership

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest in;
2. ☐ an assignee of less than the entire right, title, and interest in
(The extent (by percentage) of its ownership interest is _____ %); or
3. ☐ the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy therefore is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: John HildrethTo: Engineered Framing Systems

The document was recorded in the United States Patent and Trademark Office at

Reel 015741, Frame 0309, or for which a copy thereof is attached.2. From: Engineered Framing SystemsTo: John Hildreth

The document was recorded in the United States Patent and Trademark Office at

Reel 019969, Frame 0153, or for which a copy thereof is attached.3. From: John HildrethTo: Corsair Special Situations Fund L.P.

The document was recorded in the United States Patent and Trademark Office at

Reel 020279, Frame 0916, or for which a copy thereof is attached.

- ☒ Additional documents in the chain of title are listed on a supplemental sheet(s).

- ☒ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

Gianna J. Arnold

Printed or Typed Name

Date

6/22/10Principal

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Total Assignments: 6

Patent #: 7299596 **Issue Dt:** 11/27/2007 **Application #:** 10828350 **Filing Dt:** 04/21/2004

Publication #: 20050235594 **Pub Dt:** 10/27/2005

Inventor: John Hildreth

Title: FRAMING SYSTEM

Assignment: 1

Reel/Frame: 015741/0309

Recorded: 08/30/2004

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: HILDRETH, JOHN

Exec Dt: 08/23/2004

Assignee: ENGINEERED FRAMING SYSTEMS

8950 ROUTE 108 SUITE 228
COLUMBIA, MARYLAND 21045

Correspondent: SUPERVISOR, PATENT PROSECUTION SERVICES
PIPER RUDNICK LLP
1200 NINETEENTH STREET, N.W.
WASHINGTON, D.C. 20036-2412

Assignment: 2

Reel/Frame: 019969/0153

Recorded: 10/16/2007

Pages: 2

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: ENGINEERED FRAMING SYSTEMS

Exec Dt: 10/15/2007

Assignee: HILDRETH, JOHN

7811 FIELDSTONE COURT
ELLCOTT CITY, MARYLAND 21043

Correspondent: JAMES M. HEINTZ
500 8TH STREET NW
DLA PIPER US LLP
WASHINGTON, DC 20004

Assignment: 3

Reel/Frame: 020279/0916

Recorded: 12/26/2007

Pages: 9

Conveyance: SECURITY AGREEMENT

Assignor: HILDRETH, JOHN

Exec Dt: 12/20/2007

Assignee: CORSAIR SPECIAL SITUATIONS FUND, L.P.

747 THIRD AVENUE
38TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent: MILES & STOCKBRIDGE P.C.
10 LIGHT STREET
BALTIMORE, MD 21202

Assignment: 4

Reel/Frame: 021531/0036

Recorded: 05/22/2008

Pages: 6

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: HILDRETH, JOHN

Exec Dt: 05/16/2008

Assignee: CORSAIR SPECIAL SITUATIONS FUND, LP
747 THIRD AVENUE - 38TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent: GIANNA JULIAN-ARNOLD
MILES & STOCKBRIDGE P.C.
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VIRGINIA 22102

Assignment: 5

Reel/Frame: 022597/0396

Recorded: 04/24/2009

Pages: 3

Conveyance: CONFIRMATORY PATENT SECURITY INTEREST

Assignor: HILDRETH, JOHN J.

Exec Dt: 04/24/2009

Assignee: CORSAIR SPECIAL SITUATIONS FUND, L.P., A DELAWARE LIMITED PARTNERSHIP
747 THIRD AVENUE
38TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent: PHILIP J. FORET
1500 MARKET STREET
SUITE 3500E
PHILADELPHIA, PA 19102

Assignment: 6

Reel/Frame: 024563/0669

Recorded: 06/22/2010

Pages: 3

Conveyance: ORDER OF U.S. DISTRICT COURT FOR DISTRICT OF MARYLAND

Assignor: HILDRETH, JOHN

Exec Dt: 06/09/2010

Assignee: CORSAIR SPECIAL SITUATIONS FUND, L.P., A DELAWARE LIMITED PARTNERSHIP
747 THIRD AVENUE
38TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent: GIANNA J. ARNOLD, MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND**
Northern Division

CORSAIR SPECIAL SITUATIONS FUND, L.P.,

Plaintiff,

v.

ENGINEERED FRAMING SYS., INC.,

Defendants

*

*

*

*

*

*

Case No.: 09-1201-PWG

* * * * *

ORDER

For the reasons stated in the foregoing Memorandum Opinion, it is this 9th day of June, 2010, ORDERED and ADJUDGED that:

1. Plaintiff's Motion for Summary Judgment as to damages and declaratory relief is GRANTED;
2. Judgment is entered against Defendants in the amount of \$4,875,000.00 with interest at six percent from June 30, 2008 through the date of this Judgment;
3. Corsair is the lawful assignee and owner of the Patent, together with any and all inventions and improvements described or claimed, divisions, continuations, continuations-in-part, reissues and extensions, and all rights corresponding to any of the foregoing throughout the world;
4. Corsair can sell, assign, transfer, pledge, license or encumber the Patent free and clear from any claims of Defendant John J. Hildreth;

5. Defendant John J. Hildreth has no rights in the Patent or to use the patented technology;
and

6. The Clerk of the Court CLOSE this case.

_____/S/_____
Paul W. Grimm
United States Magistrate Judge

lmy